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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,741	08/12/2002	Geoff Campbell	109.001/U	6603

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BUCKLEY, MASCHOFF, TALWALKAR LLC
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EXAMINER

SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/064,741

Applicant(s)

CAMPBELL ET AL.

Examiner

Cristina Owen Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response too applicant's amendment filed September 1, 2006. Claims 1, 21, and 30 have been amended. Claims 1-30 are currently pending in this case.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on February 12, 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

3. Applicant's arguments filed September 1, 2006 have been fully considered but they are not persuasive.

4. Applicant argues, with respect to the independent claims 1, 21 and 30 that the cited prior art does not read on the claims as amended. Specifically that nothing in the art teaches or suggests a decoy file that that includes a defect and embedded information to distinguish the decoy files from the item of content. Attention is directed to Hale:

"The process then creates media files 5.03 with file names, extensions and sizes matching those extracted from the property sets pulled from the MMDB 5.96. The actual content of the decoy media can assume various forms. Typical content for decoy media can include, ***without limitation***; white noise, degraded versions of proprietary media, warnings of the legal consequences of sharing copyrighted media, advertisements and other desired decoy media." At col 8 ln 10-18. emphasis added.

5. Note that the advertisements, and copyright warnings are examples of embedded data in the decoy files. Also, just as advertisements can be embedded, so can a digital signature or hash.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-30 are rejected under 35 U.S.C. 9 103 as being unpatentable over Hale et al(6732180).

Regarding claim 1, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 2545, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose a method for monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media substantially as claimed. The differences between the above and the claimed invention is the use of explicit use of a defect in a decoy file. It is noted that a degraded file is by definition defective which is functionally equivalent to the claim limitations. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Hale et al because the plurality of degraded decoy files are conventional functional equivalents of the claim limitations because decoys must be defective relative to the original files. Regarding the agent limitations of

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claim 2, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media that are conventional functional equivalents of the claim limitations. Regarding agent limitations of claim 3, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 550, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media that are the conventional equivalents of the claim limitations. Regarding network limitations of claim 4, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 1030 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media that is conventional functional equivalent of the claim limitations. Regarding the analyzing limitations of claim 5, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media that are conventional functional equivalents of the claim limitations. Regarding comparison limitations of claim 6, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 1030 and claims 1-16)

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disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding adjusting limitations of claim 7, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 1030 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding comparing limitations of claim 8, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 1030 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding agent limitations of claim 9, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 550, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding format limitations of claims 10-12, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50,

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Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding file limitations of claim 13, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 550, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8; lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding number limitations of claim 14, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 550, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding detecting limitations of claims 15-16, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim

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limitations. Regarding number limitations of claims 17-18, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies(sufficient to degrade network performance) in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding monitoring limitations of claims 19 and 20, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding marking limitations of claim 21, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding identifier limitations of claim 22, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded

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versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding file limitations of claim 23, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding decoy file limitations of claims 24-27, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding validating limitations of claims 28-29, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 25-45, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose monitoring peer to peer networks, manufacturing an overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media including matching format of the decoy to produce a better decoy that is conventional functional equivalent of the claim limitations. Regarding claim 30, Hale et al (See abstract, Figs. 3-9, Col. 3, lines 40-50, Col. 4. lines 5-50, Col. 6, lines 2545, Col. 7, lines 40-60, Col. 8, lines 10-30 and claims 1-16) disclose a method for monitoring peer to peer networks, manufacturing an

overwhelming number of decoy copies in a plurality of formats including degraded versions of proprietary media substantially as claimed. The differences between the above and the claimed invention is the use of explicit use of a defect in a decoy file. It is noted that a degraded file is by definition defective which is functionally equivalent to the claim limitations. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Hale et al because the plurality of degraded decoy files are conventional functional equivalents of the claim limitations because decoys must be defective relative to the original files.

8. Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


PIERRE EDDY ELISCA
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cristina Owen Sherr
Patent Examiner, Au 3621